

REMARKS

Responsive to the notice of non-compliant amendment, applicant is refiling the reply filed on October 10, 2006 with a complete listing of all of the claims. Also, a minor amendment is made in this reply, one not made in the October 10 reply (the amendment deletes a duplication of the word process in claim 27). Applicant does not agree with the examiner that a complete listing of the claims is required with a reply that makes no amendment, but in the interest of expediting prosecution, the text of the claims is included. The text of the remarks of the reply filed on October 10, 2006 was as follows:

The examiner objects to the language of claims 9-10. The examiner seems to believe that English grammar requires the changes proposed in the office action, but the claims are grammatically correct as they stand. And the changes proposed by the examiner would be, without question, grammatically incorrect.

The examiner has rejected claim 1 under 35 USC 112, second paragraph, based apparently on a lack of understanding of the claim. The examiner asks "what is going to be changed"? The answer to the examiner's question is clearly spelled out in the claim – "the location at which the process is performed can be changed between server and client at run time." It could not be put more clearly. What changes is the location at which the process is performed. There are two locations at which the process can be performed – client and server – and the location is changed on the fly. (And it is clear from the examiner's patentability rejection that this is understood.)

The examiner also notes that "it is not clearly indicated base on what information so that the process should be run at the server or client (i.e. system performance, load, quality of service, or the configuration of the servers or clients)." Again, the claim language is perfectly clear, and could not be any clearer. The claim calls for "making a load-balancing determination as to whether the process should be run at the server or the client". The decision is based on load balancing. If the server is more heavily loaded, and the client is less heavily loaded, the decision would be to run the process at the client, and vice versa.

The examiner has withdrawn the earlier rejection under 35 USC 103 based on the AAPA publication combined with Ando. But he has substituted a new ground of rejection that is just as weak as the one withdrawn. The independent claim (1) is rejected under 35 USC 103 as being unpatentable over Field combined with the same Ando reference.

The heart of the invention is that the location (client or server) at which the known web browsing processes of parsing and layout are run is dynamically varied depending on the outcome of a load balancing determination. In other words, one or both of those processes could be run at either the server or the client, and the choice is made "at run time" (i.e., during execution of the software) based on a load balancing determination.

Field merely discloses that web browsers include those three known processes (parsing, layout, and rendering). Ando merely discloses the general notion that in client/server computing the location at which a process is performed may be dynamically varied. There is nothing in either reference to suggest the invention. Web browsers had been widely known for over a decade at the time of the invention, and the general notion taught in Ando had been known for a longer period. Thus, if a combination was obvious, as the examiner asserts, surely it would have been thought of long before the invention. The fact that Fields could be filed in 1998, many years after web browsers were well known, and many years after the notion of Ando was well known, without any suggestion of the invention, is persuasive of nonobviousness.

The examiner has not supplied any valid motivation for combining Ando with Fields. What the examiner has done is simply parrot the advantages of making the combination that he has learned by reading the inventor's application. But these advantages were not known in the prior art. It is well settled law that the motivation for making a combination cannot be advantages first taught by the inventors.

Claim 1 is thus in condition for allowance.

The remaining claims are all properly dependent on claim 1, and thus allowable therewith. Each of the dependent claims adds one or more further limitations that enhance patentability, but those limitations are not presently relied upon. For that reason, and not because

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applicants agree with the examiner, no rebuttal is offered to the examiner's reasons for rejecting the dependent claims.

Allowance of the application is requested.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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